



serle court

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Michael Edenborough KC

Year of Silk: 2010 Year of Call: 1992

"Michael's strengths are his wide but detailed knowledge of IP law, and ability to find ways through complex issues. As an advocate, he is calm, measured and clear in his submissions and responses to questions from the bench - one of the best KCs at the IP Bar, particularly for trade mark work."

The Legal 500

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Practice Overview

Michael's practice involves advice and advocacy on infringement and validity issues concerning all types of IPRs. As such, he deals with declarations of invalidity, revocation, rectification and cancellation of registered intellectual property rights such as trade marks, registered designs and patents. He is often instructed in cases involving the main unregistered IPRs such as goodwill, copyright, designs and confidential information, and also the more unusual rights such as plant varieties, moral rights, database rights and geographical indications. Further, he has been instructed on matters dealing with title to IPRs, Freedom of Information requests relating to IPRs, data protection, the calculation of the financial relief and what other remedies that might be available.

His forte is finding points of law and practice that can be invoked in order to solve a problem that has arisen for the client (be it lay or professional).

In addition, Michael acts as an expert witness on points of English law in foreign cases, and as a mediator in IP cases - in particular where the parties wish to adopt the facilitative approach for their mutual advantage.

Areas of Expertise

Intellectual Property

Principal Areas of Practice within IP

- Trade marks and passing-off
- Copyright and designs (both registered and unregistered)
- Patents and trade secrets / confidential information
- Others IPRs such as plant varieties, certification and collective marks, geographical indications (e.g. PDOs, PGIs, and TSGs), database rights and moral rights

Michael aims to provide commercial solutions for his clients, so as to place them in the best possible position to protect, exploit and enforce their IPRs, or to avoid or minimize their liability if threatened by such rights, be it by negotiation, ADR, registration, litigation or otherwise. His forte is tricky points of law and practice.

He has acted for the Comptroller-General of Patents, the Registrar of Trade Marks and the UK Government before the Court of Justice of the European Union, the House of Lords, the Court of Appeal and the High Court (both Chancery Division and Patents Court) on, inter alia, appeals from the Patent Office and the Registry. He has been instructed by the Chartered Institute of Patent Attorneys, the Chartered Institute of Trade Mark Attorneys and AIPPI UK to advise and act for them in the Court of Justice and the Supreme Court. He used to appear often (but now shadow drafts the pleadings) before the General Court of the European Union (formerly the Court of First Instance), Luxembourg on appeals from the EU IPO, and on Article 267 references and appeals to the Court of Justice (over 50 cases in all). He has also acted before both the legal and technical Boards of Appeal and the Opposition Division of the European Patent Office. He has acted in literally hundreds of matters before the trade mark registry, and in many tens of appeals to the Appointed Person and the High Court.

Michael took silk in 2010, which was 12 years after his first reported case. He now has over 150 cases in the law reports, two-thirds of which were appeals or judicial reviews.

The following reported cases are merely a selection of the more important and/or interesting ones to illustrate the type of work in which he is commonly instructed. Some areas of his practice are under-represented by reported cases, as those areas settle more often than others before reaching court and so do not result in a reported case (this is

particularly so for GI cases and the patent/confidential information matters in which he is involved).

Trade Marks and Passing-Off Substantive Law

Thatchers Cider Co v Aldi Stores [2025] EWCA Civ 5, [2025] FSR 9, [2025] ETMR 15: an appeal on what amounts to unfair advantage in the context of lookalike packaging.

Lifestyle Equities v Royal County of Berkshire Polo Club [2023] EWHC 1839 (Ch), [2023] ETMR 37, [2023] FSR 22; [2024] EWCA Civ 814, [2024] ECC 20, [2024] FSR 32: whether it is appropriate to consider third parties' activities when assessing the existence of the likelihood of confusion.

Oatly v Dairy UK [2023] EWHC 3204 (Ch), [2024] RPC 5; [2024] EWCA Civ 1453, [2025] ECC 5: appeals on the rare section 3(4) absolute ground of refusal for registration of a trade mark.

Easygroup v Beauty Perfectionists [2024] EWHC 1441 (Ch), [2024] ETMR 36, [2024] FSR 28: a trade mark trial raising issues of long-standing use and partial revocation.

Lifestyle Equities v Amazon UK Services [2021] EWHC 118 (Ch), [2021] ETMR 27, [2021] FSR 19; [2022] EWCA Civ 552, [2022] FSR 20, [2023] BusLR 1010, [2023] 1 All ER 905; [2024] UKSC 8, [2024] 3 All ER 93, [2024] BusLR 532, [2024] FSR 21: successfully defended an appeal to the Supreme Court on whether the Amazon.com website targeted consumers in the UK / EU.

EasyGroup v Easy Live (Services) [2022] EWHC 3327 (Ch), [2023] ETMR 12; [2023] EWCA Civ 1508, [2024] ECC 2, [2024] BusLR 141, [2024] FSR 15: at trial, cross-examination established that the Defendants had taken unfair advantage of the Claimant's trade marks. This was the first time that infringement was established by easyGroup of a third party's use of a non-orange, non-travel sector sign. The successful appeal concerning what constituted damage for a licensor in a passing-off case.

Standard International Management v EUIPO Case T-768/20, EU:T:2022:458, [2022] ETMR 44: a General Court case establishing for the first time that the concept of targeting applies equally to genuine use cases as it does to infringement claims. Leading Stephanie Wickenden, also of Serle Court. This was the last case filed by UK counsel before the UK exited the EU.

Fromageries Bel v J Sainsbury [2019] EWHC 3454 (Ch), [2020] ETMR 14, [2020] BusLR 440, [2020] RPC 3: an appeal to the High Court concerning the invalidation of a colour/shape mark due to lack of certainty.

Skullduggery Rum v Globefill [2020] ETMR 9: 3D trade mark in the shape of a human skull, Article 7(1)(e)(iii) added value issues.

Lifestyle Equities v Santa Monica Polo Club [2017] EWHC 3313 (Ch), [2018] FSR 15: a trade mark trial concerning the logo of a polo player where the potentially differentiating words "Beverley Hills" and "Santa Monica" were held not sufficient to avoid liability.

Moroccanoil Israel v Aldi Stores [2014] EWHC 1686 (IPEC), [2014] ETMR 55, [2015] ECC 6, [2015] FSR 4: a trial for passing-off with respect to look-a-like packaging.

adidas v Marca Mode Case C-102/07, EU:C:2008:217, [2008] BusLR 1791, [2008] ECR I-2439, [2008] FSR 38, [2008] ETMR 44: acted for the UK Government on the scope of protection that should be afforded to a mark that was distinctive only by reason of acquired distinctiveness, in this case the three-stripe mark.

West (t/a Eastenders) v Fuller Smith & Turner (ESB) [2002] EWHC 122 (Ch), [2002] FSR 55, [2003] ETMR 30;

[2003] EWCA Civ 48, [2003] FSR 44, and costs judgment [2003] EWCA Civ 429, [2004] FSR 32: reducing the specification of the ESB trade mark from “beer” to “bitter”.

Trade Marks and Passing-Off Procedural Issues

Crafts Group LLC v M/S Indeutsch International [2023] EWHC 1455 (IPEC), [2023] ECC 18, [2023] FSR 23; and [2023] EWHC 1914 (IPEC), [2023] FSR 24; [2024] EWCA Civ 87, [2024] FSR 19: at first instance the case revolved around whether a counterclaim for EU TM infringement brought after IP Completion Day could establish EUTMR jurisdiction; on appeal the central issue was the correct basis for granting a stay in an EU trade mark case.

Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd [2022] EWHC 1244, [2022] FSR 22: an application concerned with the compliance of non-expert trade evidence in a trade mark matter to PD57AC.

Chanel v EUIPO Case T-44/20, EU:T:2021:207, [2021] ETMR 40: an appeal to the General Court to determine whether an earlier trade mark may be re-orientated spatially so as to increase its similarity with the latter application.

Praesidiad v Tescon Sicherheitssysteme Schweiz BL O-240-20, [2020] FSR 33: an appeal to the Appointed Person on the nature of discretion to extend time in which to serve a TM8.

Lifestyle Equities v Royal Country of Berkshire Polo Club [2018] EWHC 3552 (Ch), [2019] FSR 14: securing jurisdiction over foreign defendants for acts of infringement committed overseas.

Pinterest v Premium Interest [2015] EWHC 738 (Ch), [2015] ECC 14, [2015] ETMR 30, [2015] FSR 27: whether a CTM confers a right to use that provides a freestanding defence to a passing-off action.

CIPA's TM Application (IP TRANSLATOR) BL O-215-10, [2010] RPC 31; Case C-307/10, EU:C:2012:361, [2013] ETMR 42; [2013] RPC 20: an Article 267 TFEU reference to the CJ on the proper construction of a trade mark specification of goods and services: "means-what-it-says" vs "class headings covers all" approach.

Budejovicky Budvar v Anheuser-Busch [2009] EWCA Civ 1022, [2010] RPC 7: an appeal on the issue of statutory acquiescence, which became the subject of an Article 267 reference to the Court of Justice (Case C-482/09, EU:C:2011:605).

Imagination Technologies v OHIM (Pure Digital) Case T- 461/04, EU:T:2007:294, [2008] EMTR 10, appealed to the ECJ Case C-542/07 P, EU:C:2009:362, [2010] ETMR 19: concerned the date by which a trade mark application needs to have acquired a distinctive character.

Copyright, Designs and Moral Rights

Marks and Spencer v Aldi Stores [2024] EWCA Civ 178, [2024] ECDR 17, [2024] FSR 16: an appeal concerning which designs are appropriate to include within the state of the art, in particular with respect to the claimant's own previous designs (the Christmas Gin Bottle case).

Islestarr Holdings v Aldi [2019] EWHC 1473 (Ch), [2020] ECDR 20: a summary judgment application on whether the relief pattern in make-up powder was protectable by copyright and duly infringed.

Utopia Tableware v BBP Marketing [2013] EWHC 3483 (IPEC), [2014] ECC 34: trial of registered and unregistered design rights in the design for a beer glass.

Temple Island Collections v New English Teas [2012] EWHC 108 (Ch), [2012] 2 CMLR 16, [2012] FSR 9: the scope of

protection of a digitally manipulated photograph (the Red Bus case).

Harrison v Harrison [2010] EWPC 3, [2010] FSR 25, [2010] ECDR 12: a rare case concerning the moral rights of derogatory treatment and false attribution.

Landor & Hawa v Azure Designs [2005] EWPC 45, [2006] FSR 22; [2006] EWCA Civ 1285, [2006] ECDR 31, [2007] FRS 9: leading case on the "method or principle of construction" exclusion to UK design right and the "technical function" exclusion to Community design right.

Woodhouse v Architectural Lighting Systems [2005] EWPC (Des) 25, [2006] RPC 1, [2006] ECDR 11: registered and unregistered design right infringement trial concerning street lamps; and the leading case on cancellation of a registered design on grounds that the applicant was not entitled to the related unregistered right.

Lambretta Clothing v Teddy Smith [2004] EWCA Civ 886, [2005] RPC 6: leading case on the interaction between copyright protection and design right protection.

Blayney (t/a Aardvark Jewellery) v Clogau St David's Gold Mines [2002] FSR 14; [2002] EWCA Civ 1007, [2003] FSR 19: leading case on the quantification of damages in a copyright infringement action.

Patents

Michael is regularly instructed on a wide variety of patent and technical confidential information cases, covering such technologies as biotech gene mutations, pharmaceuticals, mechanical devices, and methods of doing business. He is also instructed as a part of a team of counsel in patent / confidential information cases that involved other areas of law such as competition, directors' duties and general commercial matters. For example, in a case for the Department of Health, he is the IP silk along with another silk and two juniors in a competition / abuse of the patent system allegation relating to the patenting and supply of a widely-used pharmaceutical; further, he was the junior silk in a 28-day trial involving allegations of breaches of directors' duties relating to two high-tech North Sea oil drilling companies that included patent and copyright issues.

Jones v Irmac Roads Ltd [2022] EWHC 495 (IPEC), [2022] FSR 18: a case that decided that the equitable assignment of an invention needed to be in writing, as is the case with the assignment of a patent application or a granted patent. Acted *pro bono publico*.

Toshiba's App J-09/07 [2009] EPOR 17: acted for the appellant before the Legal Board of Appeal in the EPO seeking restitutio in integrum for a missed priority deadline.

Blacklight Power v Comptroller-General of Patents [2008] EWHC 2763 (Pat), [2009] RPC 6, [2009] BusLR 748: acted for the Comptroller-General of Patents in this appeal from the Patent Office, which concerned the appropriate test for inventions that might not have any industrial applicability. The purported invention involved a novel species of hydrogen as proposed by the Grand Unified Theory of Classical Quantum Mechanics.

Rhone-Poulenc Rorer v Yeda Research [2006] EWHC 160 (Pat), [2006] RPC 24; [2006] EWCA Civ 1094, [2007] RPC 9, [2007] BusLR 1; [2007] UKHL 43, [2007] BusLR 1796, [2008] 1 All ER 425, [2008] RPC 1: acted for the Comptroller-General of Patents in this matter dealing with entitlement proceedings, amendments to pleadings and the powers of the Comptroller-General.

R v Comptroller General of Patents, ex parte Penife [2003] EWHC 3409 (Admin), [2004] RPC 37: a judicial review of a decision of the Patent Office acting as a receiving office for WIPO.

R v Comptroller General of Patents, ex parte Ash and Lacy [2002] EWHC 541 (Admin), [2002] RPC 46: a judicial

review of a decision of the Patent Office about its powers to act *ex officio*.

Wheatley v Drillsafe [2001] RPC 7, CA: notable as the only patent case in which Aldous LJ was in the minority.

General Procedural Matters

Entertainment One UK v Cong Ty TNHH Tu Cong Nghe Va Dich Vu Sconnect Vietnam, [2022] EWHC 3295 (Ch), [2023] ECDR 10, [2023] 1 WLR 2333: the leading case on electronic service of originating documents.

Enreach UK v Inreach Group [2022] EWHC 2867 (Ch), [2023] RPC 4: whether certain trade mark legislation violated a party's human rights.

Alliance Pharmaceuticals v EUIPO Case T-279/18, EU:T:2019:752, [2020] ETMR 7: construction of ambiguous trade mark specification.

Boyer v Stockbridge BL O-796-18, [2019] FSR 20: the consequences of a default judgment in the UK trade mark registry.

Hendrick v Knight BL O-323-14, [2014] ETMR 58: considered the possibility of a pro bono publico costs order before the Appointed Person.

Her Majesty's Solicitor General v Dodd [2014] EWHC 240 (QB), [2014] FSR 27: committal for contempt of court relating to false witness statements in an IP matter.

R (otao Prudential) v Special Commissioner of Income Tax [2013] UKSC 1, [2013] 2 AC 185, [2013] 2 WLR 325, [2013] 2 All ER 247: acted for AIPPI UK on an appeal to the Supreme Court on whether the common law right of legal advice privilege extended to advice given by tax accountants.

Enercon TM Case T-472/07, EU:T:2010:25, before the CFI, and then appealed to the ECJ, Case C-59/09, EU:C:2009:452: acted for ITMA in an attempt to secure rights of representation and audience for Trade Mark and Design Litigators.

Evans (t/a Firecraft) v Focal Point Fires [2009] EWHC 2784 (Ch), [2010] ETMR 29, [2010] RPC 15: acted for the CI in establishing that an estoppel can arise from a previous trade mark registry invalidation decision in a subsequent action for passing-off in the High Court.

R v DEFRA ex parte Northern Foods [2005] EWHC 2971 (Admin), [2006] ETMR 31, [2006] FSR 29, [2006] EuLR 643, [2007] 1 All ER 216: concerning the Protected Geographical Indication "Melton Mowbray Pork Pies"; the reference from the CA to the ECJ, Case C-169/06, EU:C:2007:140 on the meaning of "region" settled.

Hormel Foods v Antilles Landscape Investments [2005] EWHC 13 (Ch), [2005] ETMR 54, [2005] RPC 28: abuse of process and issue estoppel.

Reckitt Benkiser (UK) v Home Pairfum [2004] EWHC 302 (Ch), [2004] FSR 37, [2005] ETMR 94: refusal to join a new Part 20 defendant as an abuse of process in a threats action.

Art & Cultural Property

Michael has extensive experience in artistic copyright matters having acted for or against a wide range of clients, such as artists, animators, film companies, galleries and museums. Many of those cases also involved a detailed

consideration of the related moral rights that may be invoked, such as the right to be identified as the author, the right to object to derogatory treatment, and the right to negate false attribution. For example, he acted for the street artist Stik in his dispute with a gallery over the unauthorised segmentation and sale of the resultant panels of a work of art painted onto the side of a shipping container. Another moral rights case involved a dispute between a world-renowned London gallery and a leading artist that concerned the proposed removal of the artist's work that formed part of the fabric of the gallery.

He has dealt with a wide range of copyright works, such as graphic works and sculptures, and works that are not readily categorised under the CDPA 1988 such as installations and other forms of contemporary art.

Further, he has experience advising upon matters relating to artists' resale right.

Finally, he has a particular interest and expertise in works of Traditional Knowledge, Genetic Resources and Traditional Cultural Expressions, for example when protected by Geographical Indications, be they agricultural or artisanal in nature, or Plant Varieties.

Sports, Entertainment & Media

In these areas of law, various intellectual property rights are deployed to underpin the justification for the often very-large remuneration packages that are involved. It is common for the traditional boundaries of the IP rights involved to be pushed to the limit (and sometimes to stray perilously close to crossing-over). In such circumstances it is vital to ascertain precisely the proper limits of what can and cannot be done in order to ensure that the resultant contract achieves the desired objectives. In this regard, the handling of goodwill and image rights associated with sporting or entertainment celebrities is often key to formulating a solution.

Michael has acted in a wide range of cases and for a eclectic mix of clients in these areas of law. For example, he has acted for a very well known football manager and one of the leading darts players in promoting their non-sporting businesses. He has also acted for or against house-hold names, such as Harry Potter, Peppa Pig and Mickey Mouse and corporate entities such as the BBC and Entertainment One.

Mediation

Michael's particular expertise in this field is his use of the facilitative, rather than evaluative, approach to mediation. So, rather than acting as a substitute tribunal attempting to determine the relative merits of the case on incomplete evidence and partial submissions, he endeavours to find a way for the parties to reach a solution to their impasse – not one that involves compromise and dissatisfaction on each side, but one that allows each party to gain something positive from the situation. This approach often requires the parties to reconsider their previously held positions and to appreciate both the potential weaknesses in their own case and the potential strengths in the other side's case, and then to perceive where benefits can be gleaned for both sides; sometimes by working together, and on other occasions by leaving each other to follow their separate paths.

Over the years, Michael has acted as a mediator in matters that have involved a wide range of intellectual property rights, such as trade marks, passing-off, copyright, design rights and moral rights. Commonly, these matters have also involved consideration of other areas of law such as partnerships, trusts and charities. He has also acted in non-IP cases, such as land disputes.

Recommendations

Intellectual Property

Chambers & Partners (2002 to present)

The Legal 500 (2003 to present)

The Legal 500 IP Silk of the Year 2024

Quotes

"Michael is a superb KC. An excellent advocate who is fearless in combat. He does his research and has excellent command of a case." Chambers & Partners 2025

"Michael has an unrivalled knowledge of trade mark opposition procedure." Chambers & Partners 2025

"Michael is an excellent and very user-friendly silk." Chambers & Partners 2025

"Michael is a very strong advocate who is clever and tactically really good. He focuses on maximising the strong points, he has a strong presence, and he is not afraid to get stuck in when necessary." Legal 500 2025

"Michael Edenborough KC is an exceptionally bright and affable barrister. He takes it all in his stride. He provides excellent service and is always thinking ahead. ... [He] stands out in his attention to detail and commitment to the cause. ... [He] breaks the mould for a KC as he rolls [up] his sleeves and [does] the work with his team. He never sits on the sidelines. He also gives invaluable advice." Chambers & Partners 2024

"Michael Edenborough is most generally regarded as the absolute guru in trade mark law. ... He's like an encyclopedia. ... and his advocacy is highly persuasive." Chambers & Partners 2023

"Michael's strength is in the clarity of his thinking and presentation of submissions to the court. He is also very good at thinking round problems and suggesting ways to overcome them." Legal 500 2023

'He is fantastic: a heavyweight silk particularly on trade mark matters. He is very user-friendly and is a good cross-examiner with a very nice demeanour with the court. He gets to the nub of the point quickly.' Chambers & Partners 2022

'Michael is supremely knowledgeable and very incisive. He is exceptionally good with clients and at explaining difficult issues in a clear, concise and thoughtful way.' Legal 500 2022

Michael Edenborough KC at Serle Court is recognised for his *"unrivalled depth of knowledge relating to UK trade mark law"* as well as his *"tenacious and robust approach to advocacy"* and *"persuasive manner and confidence in court"*. Who's Who Legal 2021

"He is both an analytical and a tactical thinker." "He is very responsive and proactive." Chambers & Partners 2021

"Michael's strengths are his wide but detailed knowledge of IP law, and ability to find ways through complex issues. As an advocate, he is calm, measured and clear in his submissions and responses to questions from the bench - one of the best KCs at the IP Bar, particularly for trade mark work." The Legal 500 2021

"One of the best silks for trademark work, he is brilliantly strategic and tactical." The Legal 500 2020

"A seasoned silk highlighted for his deep expertise in trademark law. He has additional expertise in patents and design rights disputes. ... He is thorough and highly knowledgeable while being good with clients; a real heavyweight"

for trade mark work; [and] a very bright and careful thinker." Chambers & Partners 2020

Publications

IP and the Protection of Cultural Icons

European Young Bar Association – 30 September 2023

[Handout available here](#)

The Perils of Co-Existence Agreements

CITMA webinar - 10 February 2021

[Handout available here](#)

Cats and Dogs and Commercial Property Considerations

Solicitors' Journal 2019, 162(10), pp 58-59

[Handout Available](#)

Goodwill, or not...?

CITMA, Manchester, 23.11.2017

[Handout Available](#)

Combating the spread of pirated products: experience and prospects

WIPO Regional Seminar, Kyrgyz Republic, 23.06.2016

[Handout Available](#)

Poisonous Priorities in Patent Matters

Reddie & Grose, 26.03.2014

[Handout Available](#)

Quantum in IP Matters

Hogan Lovells, 10.12.2013

[Handout Available](#)

IP Enforcement in the UK and Europe

Palo Alto, USA, 08.03.2012

[Handout Available](#)

The Art of Trade Mark Litigation

LSE, 14.01.2010

[Handout Available](#)

Sex and Swastikas

UK IPO, 31.07.2008

[Handout Available](#)

Major Publications and Committees

Author of "Contentious Trade Mark Registry Proceedings", CITMA – 2nd edition, October 2023

Consultant Editor of "Butterworths Intellectual Property Law Handbook" - 13th edition August 2017, 14th edition September 2019, 15th edition October 2021, 16th edition December 2023

Contributor to the "Concise Commentary on European Trade Mark and Design Law" - 2011

Revised the chapter on Plant Variety Rights for "Intellectual Property in Europe" – 2nd edition 2002

Author of "Organic Reaction Mechanisms: A Step-by-Step Approach" – 2nd edition 1999, hardback and eBook 2017

Author of "Lecture Notes on Intellectual Property Law" – 1st edition 1995, reprinted 1997

Member of the UK IPO Marks and Design Forum

Member of the former UPC and Enforcement Framework Review Groups, and of the former Law Commission's Advisory Panel on Groundless Threats

In the Press

Mentioned in [*'M&S settles lawsuit with Aldi over Colin the Caterpillar cake'*](#) Retail Gazette

Quoted in [*"Hostesses told to disregard NDAs at infamous London dinner"*](#) The Global Legal Post, 14.02.2018

[*'Land Rover Defender lacks 'distinctiveness', court rules'*](#) comments for Intellectual Property Magazine

[*'Meghan Markle and Harry BACK DOWN on Sussex Royal brand – trademark application withdrawn'*](#) comments in The Daily Express

Education & Qualifications

MA (Natural Sciences), Cambridge.

DPhil (Biophysics), Oxford.

Memberships

Associate Member of CIPA and CITMA

Member of AIPPI and the Royal Society of Chemistry
